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09/871,349	05/31/2001	Paul J. Bryan	4822-001	9565
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COATS & BENNETT, PLLC P O BOX 5 RALEIGH, NC 27602			EXAMINER MENDIRATTA, VISHU K	
			ART UNIT	PAPER NUMBER
			3711	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Application/Control Number: 09/871,349

Page 2

Art Unit: 3711



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/871,349

Filing Date: May 31, 2001

Appellant(s): BRYAN, PAUL J.

Paul J. Bryan
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/28/05

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The grouping of claims in brief is correct.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 3711

(9) Prior Art of Record (Response to Second issue in remand dated 6/29/06 identifying HUNSBERGER)

4998736 Elrod 3-1991

6279908 Hunsberger 8-2001

IN RE JOHN NGAI and DAVID LIN

03-1524, (Serial No. 09/597,608)

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

367 F.3d 1336; 2004 U.S. App. LEXIS 9381; 70 U.S.P.Q.2D (BNA) 1862

May 13, 2004, Filed

In re MAX A. GULACK

Appeal No. 82-580

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

703 F.2d 1381; 1983 U.S. App. LEXIS 13575; 217 U.S.P.Q. (BNA) 401

March 30, 1983

Ex. Parte Breslow 192 USPQ 431 Opinion dated July 22,1975

(10) Grounds of Rejection

Claims 1-11,13-15 rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 11/24/04 and reproduced below.

The grounds of rejection conform the Board of Appeals and Interferences remand dated 6/30/04 advising the examiner to consider rejection of claims 1-11 and 13-15 in light of the printed matter doctrine.

Claims 1-5,7-11,13,15 rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod (4,998,736) in view of Ex. Parte Breslow 192 USPQ 431 or In re Ngai F.3d 1336 (Fed.Cir 2004) or In re Gulack 703 F.2d 1381 (Fed.Cir. 1983).

Claims 1,7-10,11,15: Elrod teaches a game board comprising a plurality of paths (spaces 1-118) leading to a performing stage (see FINAL STAGE on Fig.1), a series of tokens for players (128), a starting point (space 1, Fig.1), at least one die (142), a supply of money (122), at least two decks of cards (124,126), a first deck of cards (124) as consequence cards having a key to path (col.9, line 55 "lose a turn"), and a second deck of cards (126) including a plurality of groups of cards (col.7, line 40 thru col.10, line 16).

Applicant may note that limitation "Band-member card group representing a band and members of band" is being interpreted as a rule for playing and does not add any weight to the apparatus as claimed.

Intended use of an apparatus does not add any limitation to the apparatus in the claim. Accordingly the recitation of the object of the game carries little weight towards the claimed game.

The only difference between applicant's board game and the cited reference resides in meaning and information conveyed by the printed matter and not considered as

Art Unit: 3711

patentable subject matter. The path being a network of irregular path and stage being centrally placed are aesthetic limitations and bear no criticality to playing of the game.

For that matter the path being zigzag or straight and the stage being placed at any location on the board would not change the functionality of the board.

In order to make the game attractive, it would have been obvious to vary aesthetics of the board by modifying the game path to any one of the zigzag, straight, and curvilinear without changing the scope and spirit of the game.

One of ordinary skill in art at the time the invention was made would have suggested modifying configuration of playing path and location of center stage for changing the aesthetics of the game and attracting players.

Claims 2-4: Elrod teaches a point (2:16-17) for purchasing music equipment.

"Designating a space as a Pawn space" is a matter of printing and does not change the functionality of the space.

Claim 5: Elrod does not teach playing pieces in shape of buses. In the art area of board games tokens are primarily used for the purpose of representation of a player's participation. The shape of a playing piece are determined to aesthetically please players and for matching the theme of the game. In order to make the game attractive it would have been obvious to use a playing piece in the shape of a bus to match the theme of the game.

One of ordinary skill in art at the time the invention was made would have suggested miniature buses as playing pieces.

Art Unit: 3711

Claim 13: Applicant's claim does not however provide a specific structure of a deck.

In that Elrod cards can be treated as tree decks of cards.

Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod in view of Ex.Parte Breslow/ In re Ngai/ In re Gulack as applied to claim 1 above, and further in view of Hunsberger (6279908).

Claim 6: **(Response to second issue in remand dated 6/29/06 to restate the rejection)** Elrod does not teach color-coding cards for distinguishing proper category. Hunsberger teaches color-coding cards (Fig.1) for distinguishing. In order to correspond a proper card, the art area of board games recognizes color-coding cards to correspond to a space on the board. Such practice is common and known in the art area. One of ordinary skill in art at the time the invention was made would have suggested using such commonly used techniques to match a card to a space.

Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod in view of Ex.Parte Breslow/ In re Ngai/ In re Gulack.

Claim 14: Elrod teaches a game board comprising a plurality of paths (spaces 1-118) leading to a performing stage (see FINAL STAGE on Fig.1), a series of tokens for players (128), a starting point (space 1, Fig.1), at least two decks of cards (124,126), a first deck of cards (124) as consequence cards having a key to path (col.9, line 55 "lose a turn"), and a second deck of cards (126) including a plurality of groups of cards (col.7, line 40 thru col.10, line 16). *With respect to path inwardly disposed and generally curved manner Elrod clearly indicates a possibility of an inner path (3:29-36).* The path shown by double arrows and worded "stage one" and "stage two" are not in the same straight

Art Unit: 3711

line with respect to portion of path shown by double arrows and worded "stage three, four and five" and this zigzag nature of path is being interpreted as generally curved as in the claim. This path is also placed inwardly of the outside path.

Applicant may note that limitation "Band-member card group representing a band and members of band" is being interpreted as a rule for playing and does not add any weight to the apparatus as claimed.

Intended use of an apparatus does not add any limitation to the apparatus in the claim. Accordingly the recitation of the object of the game carries little weight towards the claimed game.

The only difference between applicant's board game and the cited reference resides in meaning and information conveyed by the printed matter and not considered as patentable subject matter. The path being a network of irregular path and stage being centrally placed are aesthetic limitations and bear no criticality to playing of the game. For that matter the path being zigzag or straight and the stage being placed at any location on the board would not change the functionality of the board.

In order to make the game attractive, it would have been obvious to vary aesthetics of the board by modifying the game path to any one of the zigzag, straight, and curvilinear without changing the scope and spirit of the game.

One of ordinary skill in art at the time the invention was made would have suggested modifying configuration of playing path and location of center stage for changing the aesthetics of the game and attracting players.

Response to Declaration under Rule 1-132: Addressing the First issue in remand dated 6/29/06.

The Declaration under 37 CFR 1.132 filed 3/28/05 is insufficient to overcome the rejection of claims 1-11 and 13-15 based upon 35 USC 103 (a) as set forth in the last Office action because: Examiner is allowed to interpret “challenge, rescue or band equipment cards” as broadly and reasonably as possible. What applicant refers to as “functionality” of cards is only intended use of the indicia on cards. The indicia on Elrod cards can be used to form groups of cards and printed matter in those cards can be used for intended purpose to play a game.

(11) Response to Argument

Examiner takes the position that the 35 USC 103(a) rejections of claims 1-11,13-15 over Elrod in light of the printed matter doctrine are appropriate. The only difference between applicant's game (cards, game path) and Elrod game (cards, game path) resides in meaning and information conveyed by the printed matter and would not be patentable difference. For example Elrod cards (col.8, lines 7-34) asking the name of a band/artist can be interpreted as applicant's “band member card” or “band equipment” card. The examiner takes the position that the term “artist” on Elrod cards can be read as “band member” and the term “band” can be read as “band equipment”. These differences in the printed matter are only in the meaning and information conveyed and not in the game. The teachings provided by the cited court opinions are source of motivations in the obvious rejection.

Art Unit: 3711

Applicant's arguments that Elrod does not provide a third deck (?) of cards are not persuasive. Elrod supplies a large number of cards (7:38-10:16) that can be divided into a large number of decks as long as each deck has plurality of cards. It may be noted that a deck only means a stack of cards.

(Response to second issue in remand dated 6/29/06 to respond to Appellant's arguments)

Claim1: Board games is an amusement art area and Examiner has clearly indicated in prior rejection that aesthetic modifications such as making the path zig-zag or placing an attractive image at the center of the game board do not change the functionality of the game board. In order to make the game attractive it would have been obvious to modify game board face to include attractive indicia.

Applicant next points out at absence of a so-called third deck in Elrod. Applicant's disclosure has no clear indication of what and how many cards constitute a deck. Elrod teaches numerous cards with varied indicia on them having potential of being categorized as several decks including a so-called third deck.

Applicant's claims are apparatus claims and "challenge, rescue or band member cards" are intended use limitations not furthering the apparatus in the claim.

With regards to applying printed matter doctrine for rejecting claim 1, the examiner takes the position that the only difference between applicant's cards and Elrod cards resides in meaning and information conveyed by the printed matter and open to interpretation. As such Elrod cards can be used to play applicant's game functionally.

Art Unit: 3711

Claim 11: Applicant argues that Elrod cards are not band member cards.

Examiner takes the position that applicant's use of phrase "band member cards" is intended use and not furthering the claimed apparatus.

Claim 6: Applicant argues that the prima face case of obviousness rejection of claim 6 is flawed. Arguments are not persuasive. The examiner takes the position that the only difference between applicant's cards and Elrod cards resides in meaning and information conveyed by the printed matter and open to interpretation. As such Elrod cards can be used to play applicant's game functionally.

Claim 14: With regards to the curved shapes of paths the examiner has clearly indicated in prior rejection that aesthetic modifications such as making the path zig-zag or placing an attractive image at the center of the game board do not change the functionality of the game board. In order to make the game attractive it would have been obvious to modify game board face to include attractive indicia.

Applicant's argument that the examiner misconstrued is not persuasive. Elrod clearly teaches groups of band member cards (8:7-34) dividing in groups by letters A through Z). Further in the absence of structural differences the limitation "grouping of cards" is being interpreted as a rule of playing.

Examiner further takes the position that the criticality of a game path is in the method of playing and not in the apparatus as such. The applicant is claiming apparatus.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/871,349

Page 12

Art Unit: 3711



Respectfully submitted,

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Primary Examiner
Art Unit 3711

July 26, 2006

Conferees

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Greg Vidovich (SPE).....

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